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EXAMINER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/776,069
Filing Date: February 11, 2004
Appellant(s): SANDERS ET AL.

MAILED

JUL 16 2007

Technology Center 2100

Sue Z. Shaper
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/9/2007 appealing from the Office action mailed 1/25/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Pricewatch (www.pricewatch.com, webpages from 1/28/2003), Yahoo (www.yahoo.com, webpages from 12/09/2002), Morimoto (Publication Number 2002/0013774), eBay (www.ebay.com webpages from 11/15/2002), Google (www.google.com webpages from 2/22/2002).

(9) Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

* Claims 21 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Including "more than simply geographic" is not sufficiently described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-18,22-26,36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The term "cutting edge technology" in claim 18 is a relative term which renders the claim indefinite. The term "cutting edge technology" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. The term "more than simply geographic" does not sufficiently define what is being claimed.

Claim 24 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The term "cutting edge technology" in claim 26 is a relative term which renders the claim indefinite. The term "cutting edge technology" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "more than simply geographic" does not sufficiently define what is being claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11,13-37,39,41-42 are rejected under 35 U.S.C. 103(a) as being obvious over Pricewatch (www.pricewatch.com, webpages from 1/28/2003) in view of Yahoo (www.yahoo.com, webpages from 12/09/2002).

As per claim 1, Pricewatch teaches

An improved Internet Directory System, comprising: (page 1)

the plurality of CDWs each providing at least a lower level directory referencing websites (WSs) relating to a category; (page 2)

the CDWs being identified as Category Directory Websites participating in the System by at least a mark or a URL portion; (page 3)

and a business model imposed on at least the CDWs. (pages 4-5)

Pricewatch does not explicitly indicate "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories

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and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)".

However, Yahoo discloses "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 2, Pricewatch teaches
the business model includes standards of operation imposed on the plurality of CDWs by the System. (page 5)

As per claim 3, Pricewatch teaches
a standard of operation includes professional management. (page 5)

As per claim 4, Pricewatch teaches
a standard of operation includes organization and comprehensiveness. (pages 1-3)

As per claim 5, Pricewatch teaches
a standard of operation includes up-to-dateness. (page 4)

As per claim 6, Pricewatch teaches
a standard of operation, imposed on at least a subset of CDWs, includes a CDW offering web sites at least one of an option to move to a secure site to negotiate a purchase and an organization of pertinent comparative data on a subject within the category. (page 3 and 5)

As per claim 7, Pricewatch teaches
the business model includes charging at least some WSs for being referenced.
(page 5)

As per claim 8, Pricewatch teaches
the business model includes at least some WSs being charged for at least one service offered by a CDW. (page 5)

As per claim 9, Pricewatch teaches
the business model includes a participating CDW providing advertising space on
its site. (page 3)

As per claim 10, Pricewatch teaches
the business model includes a CDW promoting, by advertising, at least one of its
referenced websites. (page 3)

As per claim 11, Pricewatch teaches
the business model includes at least one advertising/promotion firm that provides
advertising/promotion for a category and/or a CDW site substantially in return for
advertising space on a CDW site. (page 3)

As per claim 13, Pricewatch teaches
the business model includes substantially funding operation of a CDW by
payments from WSs. (page 4-5)

As per claim 14, Pricewatch teaches
the business model includes selection of categories for CDWs large enough to
support a website and small enough to be managed according to the business plan.
(page 1-2)

As per claim 15,

Pricewatch does not explicitly indicate "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs."

However, Yahoo discloses "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 16, Pricewatch teaches
the URL portion comprises a TLD. (page 3)

As per claim 17, Pricewatch teaches
the URL portion comprises a TLD unique to CDWs and DPs in the system. (page 3)

As per claim 18, Pricewatch teaches

the business model includes at least one cutting edge technology cost effectively offered to appropriate referenced WSs. (page 3)

As per claim 19,

Pricewatch does not explicitly indicate "the plurality includes hundreds."

Yahoo discloses "the plurality" except for "the plurality includes hundreds". It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality to include hundreds, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8).

As per claim 20,

Pricewatch does not explicitly indicate "the Directory Provider comprises an ISP or Search Engine."

However, Yahoo teaches "the Directory Provider comprises an ISP or Search Engine." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the Directory Provider comprises an ISP or Search Engine" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 21, Pricewatch teaches

1) the category and 2) at least one field and/or super-category are both more than simply geographic. (page 3)

As per claim 22, Pricewatch teaches

A method for providing an Internet Directory System, comprising: (page 1)
organizing an independent for-profit directory website to reference websites within a category; (page 3)

adopting a URL portion or a mark identifying said directory website as a participating Category Directory Website; (page 3)

and abiding by a System business model imposed on said Category Directory Websites. (pages 3-4)

Pricewatch does not explicitly indicate "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs".

However, Yahoo discloses "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's

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(DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claims 23-36,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claims 2,16-18,3-5,9-10,20,11,6-7,21 and are similarly rejected.

As per claim 37, Pricewatch teaches

the business model includes minimal standards for websites to be included in a directory, for updating website references including adding new websites and for deleting no longer viable websites and standards for certain quality of presentation for participating websites. (page 5)

As per claim 39, Pricewatch teaches
the upper level fields and/or super-categories being organized to contain CDWs
which pay the DP to be listed in one or more fields, the fee based on a number of web
pages hosted or linked to the CDW. (page 5)

As per claim 41, Pricewatch teaches
the plurality includes thousands. (page 3)

As per claim 42, Pricewatch teaches
the CDWs providing lists of business and/or web pages within their category and
organizing those lists into sub-categories. (page 2)

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Pricewatch and Yahoo, and further in view of Morimoto (Publication Number
2002/0013774).

As per claim 12,
Pricewatch as modified with Yahoo do not explicitly indicate "the business model
includes offering webpage enhancement services at a volume discount."

However, Morimoto discloses "the business model includes offering webpage
enhancement services at a volume discount" (paragraph [0008]).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and Morimoto because using the steps of "the business model includes offering webpage enhancement services at a volume discount" would have given those skilled in the art the tools to improve the invention by allowing economies of scale to determine prices. This gives the user the advantage of being able to get better prices if willing to spend more money.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch and Yahoo, and further in view of eBay (www.ebay.com webpages from 11/15/2002).

As per claim 38,

Pricewatch does not explicitly indicate "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including cutting-edge technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers".

However, eBay discloses "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including cutting-edge technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers" (table 6, listing enhancements).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and eBay because using the steps of "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including cutting-edge technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch and Yahoo, and further in view of Google (www.google.com webpages from 2/22/2002).

As per claim 40,

Pricewatch does not explicitly indicate "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated".

However, Google discloses "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and Google because using the steps of "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

(10) Response to Argument

With respect to Applicants arguments regarding the outstanding 35 U.S.C. 112 rejections of claims 16 and 17 regarding the acronym "TLD" and the phrase "more than simply geographic" in claims 21 and 36, it is respectfully submitted that the aforementioned are rejections and not objections as argued by the Applicant. To summarily dismiss them as objections which were fixed in the Amendment after Final and should therefore be removed is unfair to the Examiner, who had no opportunity to properly search the intended meanings as specified in the Amendments after Final. Using such a method of entering amendments avoids a proper and timely definition so that a proper search can be made, and this makes it very difficult for Examiners to do their jobs properly and without extra work. The proper flow of prosecution should be maintained and these types of shortcuts which avoid proper definition and arguments by adding content after the fact unfairly create an additional burden on the Examiner when

they are permitted. The 35 U.S.C. 112, second paragraph, rejections of claims 16, 17, 21, and 36 are therefore maintained.

With respect to Applicants arguments regarding the outstanding 35 U.S.C. 112 rejections of claims 18, 26 and 38 regarding the phrase "cutting-edge technology", it is respectfully submitted that the term is not definite and does not distinctly define the metes and bounds of the subject matter that will be protected. Clearly the phrase interpretation varies widely over person and time in ways that are far beyond the protection which can be expected by the Applicant. In the moment it can be difficult for a person to ascertain the scope or meaning of the term in any limiting way, since the term "cutting-edge" could have widely different meanings to different people. Without a distinct definition of the metes and bounds of the subject matter the aforementioned claims are properly rejected under 35 U.S.C. 112, second paragraph, and the rejection is maintained.

With respect to the outstanding 35 U.S.C. 103(a) rejections of claims 1 and 22, and all claims which depend therefrom, Applicant argues that Pricewatch (www.pricewatch.com webpages from 1/28/2003) in view of Yahoo (www.yahoo.com webpages from 12/09/2002) do not teach "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)". It is respectfully submitted that Yahoo teaches the at least one upper-level Directory

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Provider, where the upper-level fields are the listings of companies, and the plurality of independently owned for-profit CDWs in its “alphabetical” list of companies. Each of these plurality of CDWs is independently owned and for-profit, as examining the descriptions of these companies will clearly indicate. Moving down one level into an exemplary CDW, it is respectfully submitted that Pricewatch teaches “the plurality of CDWs each providing at least a lower level directory referencing websites (WSs) relating to a category”. In explanation the Pricewatch website, which contains many of the elements of an upper level Directory Provider, can itself be considered a CDW. On the upper-half of page 2 of the Pricewatch reference, categories are defined, and in the lower half of page 2 the items in a respective category are listed. To further support this, the Examiner points to the text box and button in the middle of page 2, where the button is labeled “Search Category” which leaves doubt as to whether the Pricewatch reference teaches categories. Examining page 3 of the Pricewatch reference teaches “the lower-level directory referencing websites (WSs) relating to a category”.

Given the combination of the Pricewatch and Yahoo references, it is respectfully submitted that “at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)” is clearly obvious.

Applicant also argues that Pricewatch in view of Yahoo do not teach “the CDWs being identified as Category Directory Websites participating in the System by at least a

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mark or a URL portion", it is respectfully submitted that the Pricewatch reference, page 3, shows participation in the system is contained in every participating are in fact identified by the "Buy Online" URL. In fact, the mere inclusion of in the list at any level in the System means that anything included in that business listing could be considered a "mark", given the broadest reasonable interpretation. It is therefore respectfully submitted that the limitation is obvious over Pricewatch in view of Yahoo.

Applicant also argues that Pricewatch in view of Yahoo do not teach "a business model imposed on at least the CDWs", it is respectfully submitted that Pricewatch does in fact have a business model imposed on the participants, as disclosed on page 5, which can be taken in combination with Yahoo to make it obvious to impose a business model on the CDWs. Regardless, in absence of the Pricewatch reference, the Yahoo reference defines the "Yahoo! Commercial Directory", and has the "Company" category, which imposes the business model of a company on the CDWs in the Yahoo upper-level directory. Either way, the combination of references teaches limitation as claimed.

With regards to the Applicants argument that there is no motivation to properly combine the Pricewatch and Yahoo references, it is respectfully submitted that the accepted standards of the Internet and the myriad of websites which exist within its bounds are largely comprised of presentation and methods which propagate through mimic and combination. It is a simple matter to combine ideas, modeling, formatting, and methods, in fact all these things are literally a click away and have been

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fundamental to the growth the of the medium. The motivation to combine, even via picking and choosing elements up and down the Internet tree, is that it happens every day on the Internet, has happened since its inception, and is important to its growth and innovation.

Conclusion:

It is respectfully submitted that a combination of the references cited disclose the claimed CDW system. In light of the forgoing arguments, the examiner respectfully requests the honorable Board of Appeals and Interferences to sustain the rejection.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Jay Morrison/

Jay Morrison, Assistant Examiner, AU 2168

May 11, 2007

Conferees:

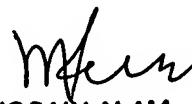
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